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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,539	02/23/2004	Carlton F. Brooks	100/12602	7748
21569	7590	12/06/2004	EXAMINER	
CALIPER LIFE SCIENCES, INC. 605 FAIRCHILD DRIVE MOUNTAIN VIEW, CA 94043-2234			DEB, ANJAN K	
			ART UNIT	PAPER NUMBER
			2858	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/784,539

Applicant(s)

BROOKS ET AL.

Examiner

Anjan K Deb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/23/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

In specification page 1, line 2, insert after "2002," -- now US Patent Number 6,750,661

B2 issued on June 15, 2004--

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-66 of U.S. Patent No. 6,750,661 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Re claims 1,6,7,11,12,19,20 U.S. Patent No. 6,750,661 B2 (claims 1,4,30,37) claimed controlling and applying first and second selectable current passed through a resistive element

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(fluid channel having an electrical resistance) and detecting at least one characteristic (resistance) indicative of a temperature of the resistive heating element to elevate fluid temperature.

Re claims 2, 3, 15, 16 U.S. Patent No. 6,750,661 B2 (claims 2,3) claimed a first selectable high frequency current of about 10 kHz, and a second selectable low frequency current of about 10 Hz.

Re claims 4,6,7,17,19,20 U.S. Patent No. 6,750,661 B2 (claims 4,30) claimed second selectable current is used to measure resistance (reciprocal of conductivity) of resistive heating path (conductive path) being indicative of the fluid temperature.

Re claims 5, 18 U.S. Patent No. 6,750,661 B2 (claims 5,25) claimed the frequency of selectable current signal is greater than 300 Hz.

Re claim 8, U.S. Patent No. 6,750,661 B2 (claim 8) claimed repeatedly cycling temperature between first and second temperature.

Re claims 9, 10 U.S. Patent No. 6,750,661 B2 (claims 9,10) claimed the material comprises reagents for performing a nucleic acid amplification reaction selected from the group consisting of a polymerase chain reaction and a ligase chain reaction.

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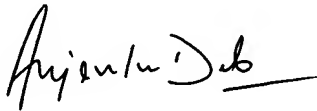
Re claims 13, 10 U.S. Patent No. 6,750,661 B2 (claim 16, 41) claimed microfluidic device (system) comprising fluid-filled channel, and further comprising the step of maintaining a global temperature of the microfluidic device at a selected level above or below ambient temperature.

Re claim 14, U.S. Patent No. 6,750,661 B2 (claims 1,56,62) claimed resistive heating element disposed on the substrate (channel disposed in a substrate having electrical resistance), controllable effector power supply (source), "probe signal source", "probe signal detector" and "controller" (see claim 62 of U.S. Patent No. 6,750,661 B2).

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***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Anjan K. Deb whose telephone number is 571-272-2228. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le, can be reached at (571) 272-2233.



**Anjan K. Deb**

Patent Examiner

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12/2/04

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